

REMARKS/ARGUMENTS

Claims 6-7, 14, and 22 are canceled.

Support for each amended claim is found at the originally filed claims and throughout the specification.

No new matter has been added.

The anticipation rejection of Claims 8, 10-12, 27 and 31 in view of Urashima is respectfully traversed. Present Claim 8 contains the feature “wherein the at least one organic suspension agent is selected from the group consisting of toluene, cyclohexanone, and combinations thereof.” This feature is not described or suggested by Urashima, therefore Urashima cannot anticipate Claim 8 and the claims depending therefrom. Withdrawal of the anticipation rejection is requested.

The anticipation rejection of Claims 1-5, 9, 18-21, 24-26, 29-30 and 32 as being unpatentable over Keller is respectfully traversed. Keller requires a film-forming binder (see, for example, the Abstract, and column 2, lines 45-47, of Keller) for the composition, which is absent from, for example, present Claim 1, because present Claim 1 employs the transitional phrase “consisting of.” Thus, present Claim 1, and the claims depending therefrom, cannot be anticipated by Keller. Withdrawal of the anticipation rejection is respectfully requested.

The obviousness rejection of Claims 8, 13, 15-18, 23, 27-28 and 31 as being unpatentable over Keller in view of Tully is respectfully traversed. Keller requires a binder. As codified in the Graham v. John Deere, the Office must apply a reference as a whole, and Keller, as a whole, requires a binder. The language cited by the Office, that “the nature of the binder depends in many cases on the desired end use and is of fairly minor importance for

the success of the invention” does not change the requirement of Keller for a binder.

Further, the use of the adjective “fairly” before “minor” makes the binder more important than merely “minor,” thus reinforcing the fact, stated clearly throughout Keller (see, for example the Abstract of Keller) that a binder is required.

Present Claim 8 employs the transition phrase “consisting of” and thus, excludes a binder.

As also clearly described in Graham v. John Deere, secondary considerations can be used to rebut an obviousness rejection, including the secondary consideration of when a reference “teaches away from” the claimed invention, as is the case here.

The Office thus finds itself in the unenviable position of twice taking a position that is directly contrary to Graham v. John Deere, and therefore not correct.

Because Keller, taken as a whole, requires a binder, and Claim 8 and the claims depending therefrom exclude a binder, Keller “teaches away from” the invention of Claim 8, and Claim 8 is not obvious in view of Keller. The disclosure of Tully does not remedy the deficiency of Keller. Thus, the obviousness rejection based on Keller and Tully is in direct opposition of Graham v. John Deere, is therefore incorrect, and should be withdrawn.

Applicants submit the application is now in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

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